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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,194	07/19/2001	Michael A. Wilkman	HOLCORP.005A	9144
20995 7590 02/25/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3622		PAPER NUMBER		
NOTIFICATION DATE 02/25/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

09/09,194

Applicant(s)

WILKMAN, MICHAEL A.

Examiner

Donald L. Champagne

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 15, 19 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 15, 19 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 20 Dec 07

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At claim 24, lines 5-6, "a transaction manager component configured to manage ... a user's interests" is new matter.
3. Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remainder of the claims, does not reasonably provide enablement for "a transaction manager component configured to manage ... a user's interests" (claim 24, lines 5-6). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.
4. "Interests" are defined as "right, title or legal share in something" (Merriam-Webster Online Dictionary). Managing such interests is a human function. It is not clear how a computer manages a person's interests. Also see para. xx below.
5. This rejection can be overcome by amending the subject material to read -- a transaction manager component configured to manage ... information including a user's interests --. That is supported at spec. para. [0047] and [0057].

Claim Rejections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-11 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US005644723A).

9. Meyer et al. teaches (independent claim 8) a method for managing promotions, comprising:

receiving, via an electronic communications medium, a plurality of promotions relating to a plurality of merchants (col. 9 lines 56-59 and col. 1 line 29);

receiving, via an electronic communications medium, user information relating to a plurality of *members/users*, wherein the *member/user* information includes *member/user* payment (i.e., *Visa credit card*) account information (col. 17 lines 15-27, col. 33 lines 10-14, including Fig. 22, item **2211**, and col. 41 lines 22-26);

matching at least one of the plurality of promotions to at least one of the plurality of *members/users* based at least upon a portion of the plurality of *member/user* information (col. 46 lines 20-42) and user payment account information (col. 24 line 1-8); and

presenting to at least one of the plurality of *members/users*, via a personal computer device (col. 7 lines 55-57), information in a promotion document about the at least one of the plurality of promotions (col. 6 lines 34-43).

10. Meyer et al. also teaches at the citations given above claims 11 and 19. Meyer et al. also teaches: claim 9 (col. 8 line 39); and claim 10 (col. 3 line 46 and col. 53 lines 35-43).

11. Claims 1, 4, 5, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. (US006397198B1)

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12. Hoffman et al. teaches (independent claim 1) a system for facilitating the matching of at least one promotion with at least one user, comprising:

a merchant management module (*rewards transaction processor*) configured to manage, via an electronic communications medium, at least one promotion (*rewards*) that corresponds to at least one of a plurality of merchants (*various reward-units issuers*, col. 4 lines 28-34);

a personal computer device (*terminal 4*, Fig. 1) configured to manage a user's preferences (col. 5 lines 49-51), wherein the personal computer device is further configured to manage a plurality of the user's accounts (*credit/debit financial accounts*) for transferring funds (col. 5 lines 27-31, where execution of a transaction reads on transferring funds, from the user to the merchant); and

a transaction module (*execution module 28*) configured to present information about the at least one promotion (*transaction-related information*) to at least one user (col. 5 lines 27-31) via the personal computer device (col. 3 line 58 to col. 4 line 2), the transaction module further configured to select at least one of the plurality of the user's accounts (col. 8 lines 37-39) to use for a commercial transaction with the at least one of a plurality of merchants (col. 6 lines 15-21 and col. 7 lines 37-58) wherein the selection is based at least in part on rules (assignment of an *account index code*, col. 8 lines 31-37) that govern which one of the plurality of the user's accounts should be used (col. 8 lines 37-39).

13. Hoffman et al. does not teach that the selection is based at least in part on the at least one promotion. However, Hoffman et al. does teach that the account is selected by the user (col. 8 lines 31-39). It would have been obvious for the user to make the selection based at least in part on the at least one promotion if there is any benefit to doing so (i.e., a special reward). In addition, under *KSR v. Teleflex* (82 USPQ 2d 1385), it is common sense that the user would choose the account that yielded the greatest benefit. Say one credit card account yielded a very high cash-back amount for all purchases made the next month. It would have been obvious for the user to program the selection module (by choosing the *account index code*, col. 8 lines 31-39) to select that card for the next month.
14. Hoffman et al. also teaches at the citations given above claims 4, 12, 13 and 15. Hoffman et al. also teaches claim 5 (col. 7 lines 59-62).

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15. Claims 2, 3, 6 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Meyer et al.
16. For independent claim 24, Hoffman et al. does not teach that the promotion relates to the user's interests. Meyer et al. teaches that the promotion relates to the user's interests (col. 6 lines 34-43 and col. 8 lines 31-37). Because Meyer et al. teaches that it is efficient to select promotions that relate to the user's interests (*interests and past purchasing behavior*, col. 1 lines 36-44 and 54-55), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Meyer et al. to those of Hoffman et al. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), it is simple common sense that the promotion would be chosen to relate to the user's interests. That is called *targeting* a promotion, and clearly would most influence a user. A golf promotion would be more effective with a person who plays golf than with a person who does not play golf.
17. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Hoffman et al teaches every feature of the claim except details for selecting the promotion. Meyer et al. teaches those details.
18. Hoffman et al. also teaches at the citations given above claim 27.
19. Meyer et al. also teaches at the citations given above claim 6. Meyer et al. also teaches claims 2 and 25 (col. 9 lines 56-59 and col. 1 line 29) and claims 3 and 27 (col. 8 lines 12-19 and col. 34 lines 16-28).

Response to Arguments

20. Applicant's arguments filed with an amendment on 21 December 2007 have been fully considered but they are not persuasive. Some arguments have been addressed by revision of the rejection.
21. Applicant argues (pp. 6-7) that the rejections of claims 24-27 under 35 USC 112 are improper because the claimed usage is disclosed. It is not, although the word "interests" is certainly disclosed. For example, as applicant has noted, "match user interests" is disclosed (at spec para. [0041]). But that means things the user is interested in, and nowhere does the spec. disclose a computer managing them. Say the user is interested in tennis. How does the computer manage this interest? As noted in the revised rejection, it is supported

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and therefore acceptable to claim a computer managing information including a user's interests.

22. Applicant argues (pp. 10-11) that Meyer et al. does not teach all the "matching" limitation of claim 8 because Meyer teaches credit card restrictions. The credit card restrictions (or lack of them) are not claimed and are therefore irrelevant. Meyer et al. teaches the "matching" limitation at the sections noted in the rejection.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
26. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

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about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

28. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
29. Applicant may have after final arguments considered and amendments entered by filing an RCE.
30. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

11 February 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3622